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MAILED
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OFFICE OF PETITIONS

In re Patent of Kei Hayasaki et al.	:	DECISION ON PETITION
Patent No. 7,364,839	:	UNDER 37 C.F.R. § 1.183
Issue Date: April 29, 2008	:	AND ON REQUEST FOR
Application No. 10/624,593	:	RECONSIDERATION OF
Filing Date: July 23, 2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 256753US96	:	

This is a decision responding to papers filed October 24, 2008, which are being treated as a petition under 37 C.F.R. § 1.183 and a petition under 37 C.F.R. § 1.705(d).

The petition under 37 C.F.R. § 1.183 is **granted**.

The petition under 37 C.F.R. § 1.705(d) is **granted to the extent indicated herein**.

The Office will *sua sponte* issue a certificate of correction setting forth a patent term adjustment determination of **zero (0) days**. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Background

The application was filed July 23, 2003.

On December 14, 2007, the Office issued a Notice of Allowance and a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) advising applicants of a patent term adjustment to date of 99 days.

A "Notice of Error in the Determination of Patent Term Adjustment" was filed March 13, 2008. The document states Applicants' calculations indicate the correct initial patent term adjustment is 39 days, not 99 days.

The application matured into Patent No. 7,364,839 on April 29, 2008. The patent sets forth a patent term adjustment determination of 99 days.

The instant petitions were filed on October 24, 2008, which was 178 days after the patent issued.

The Petition Under 37 C.F.R. § 1.183

Pursuant to 37 C.F.R. § 1.705(d), a request under 37 C.F.R. § 1.705(d) must be filed within two months of the date a patent issues. The instant petition under 37 C.F.R. § 1.183 requests the Office suspend or waive the two-month requirement.

The two-month period to file a petition under 37 C.F.R. 1.705(d) is set by regulation, not by statute. Therefore, the period may be waived pursuant to 37 C.F.R. § 1.183, which states,

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

Based on the specific facts in this case, the Office has concluded waiver of the two-month time limit is warranted. Therefore, the petition under 37 C.F.R. § 1.183 is granted.

The Petition Under 37 C.F.R. § 1.705(d)

The patent sets forth a patent term adjustment determination of 99 days. The petition under 37 C.F.R. § 1.705(d) asserts the patent should have set forth a patent term adjustment determination of 65 days.

Delay Under 37 C.F.R. § 1.703(a) ("A Delay")

The period of A Delay is 267 days and is not in dispute.

Delay Under 37 C.F.R. 1.703(b) ("B Delay")

The application was filed July 23, 2003, and a request for continued examination ("RCE") was filed August 18, 2006.

As stated in 37 C.F.R. § 1.703(b)(1), the period of B Delay does not include,

The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

The petition states the period of B Delay is 26 days. However, the period of time beginning July 24, 2006, the day after the date three years after the filing date, and ending August 17, 2006, *the day before the date the RCE was filed*, is 25 days. In other words, the correct period of B Delay is 25 days.

Overlap Between the Periods of A Delay and B Delay

The petition contends, and the Office agrees, the period of A Delay does not overlap with the period of B Delay. Therefore, the number of days of overlap is zero.

Delay Under 37 C.F.R. § 1.704 ("Applicant Delay")

The petition under 37 C.F.R. § 1.705(d), when considered in conjunction with the paper filed March 13, 2008, *appears* to assert the correct period of Applicant Delay is 228 days, not 168 days as previously calculated by the Office.

A review of the record indicates the correct period of Applicant Delay is 294 days.

Issue 1

The Office issued a final Office action on June 1, 2007.

A RCE and submission were filed on October 31, 2007.

The Office did not enter a reduction in patent term adjustment based on the facts above.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A response to the June 1, 2007 Office action was not filed until October 31, 2007, which was three months and 60 days after the Office action was issued. Therefore, the Office should have entered a 60-day reduction in patent term adjustment under 37 C.F.R. 1.704(b).

Issue 2

The Office issued a final Office action on May 19, 2006.

A RCE and submission were filed August 18, 2006.

An information disclosure statement ("IDS") was filed October 23, 2006.

The Office did not enter a reduction in patent term adjustment based on the facts above.

Per 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The IDS filed October 23, 2006, did not include a statement under 37 C.F.R. 1.704(d) and the record fails to indicate the examiner expressly requested the submission of the IDS. Therefore, a reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(c)(8).

The number of days beginning August 19, 2006, the day after the date a reply was filed in response to the May 19, 2006 final Office action, and ending on October 23, 2006, the date the IDS was filed, is 66 days. Therefore, the Office should have entered a 66-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8) as a result of the submission of the IDS.

The Total Period of Applicant Delay

The total period of Applicant Delay is 294 days, which is the sum of the 168 days of Applicant Delay previously recognized by the Office increased by 60 days for the delay under 37 C.F.R. § 1.704(b) involving a reply filed October 31, 2007, and increased by 66 days for the delay under 37 C.F.R. § 1.704(c)(8) involving an IDS filed October 23, 2006.

The Correct Patent Term Adjustment

The period of A Delay is 267 days.

The period of B Delay is 25 days.

The periods of A Delay and B Delay do not overlap.

The total period of Applicant Delay is 294 days.

The sum of 267 days of A Delay and 25 days of B Delay reduced by 294 days of Applicant Delay is -2 days. A patent cannot receive a patent term adjustment less than 0 days. Therefore, the proper patent term adjustment is 0 days.

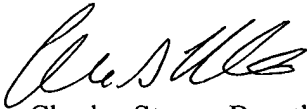
Conclusion

In view of the prior facts, the patent should have set forth a patent term adjustment determination of zero (0) days.

The petitions were accompanied by the petition fee for the petition under 37 C.F.R. § 1.183, but not by the \$200 petition fee for the petition under 37 C.F.R. § 1.705(d). Therefore, the Office has charged \$200 to Deposit Account No. 06-0916 pursuant to the general fee authorization set forth in the petition under 37 C.F.R. § 1.705(d).

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **zero (0)** days.

Telephone inquiries specific to this matter should be directed to Steven Brantley, Senior Petitions Attorney, at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,364,839 B2
APPLICATION NO. : 10/624,593
DATED : April 29, 2008
INVENTOR(S) : Kei Hayasaki et al.

DRAFT

✓
It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 99 days.

Delete the phrase "by 99 days" and insert -- by 0 days--